

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Johannes-Theodor MENKE
US Serial No.:
10/ 555,302
371 (c) Date: 11/02/2005
Confirmation No. 7807
For: MOTOR VEHICLE

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Examiner: PATEL, KIRAN B
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/Matthias Scholl/

DR. MATTHIAS SCHOLL, ESQ.

REPLY TO RESTRICTION REQUIREMENT

SIR:

In the Office Action of July 11, 2007, which did not address the merits of the above-identified patent application, claims 7-36 were subject to restriction under 35 U.S.C. § 121. As a result of the restriction requirement, the Examiner has divided the claims into 3 groups (Inventions A-C) which are alleged to constitute patentably distinct inventions:

- Invention A - Claims 7-21, drawn to a door structure;
- Invention B - Claims 22-35, drawn to a door structure; and
- Invention C - Claim 36, drawn to a door structure.

Specifically, the Examiner alleges that the restriction is proper because “these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter.”

Applicant respectfully disagrees for the reasons stated below.

Applicant submits that two criteria must be met for a proper restriction requirement:

(A) the inventions must be independent or distinct as claimed; and

(B) there would be a serious burden on the Examiner if restriction is not required (MPEP § 803).

Applicant respectfully submits that in this case, the Examiner has neither shown that the inventions are independent or distinct as claimed nor made a prima facie showing that there would be a serious burden in examining the three groups set forth in the Restriction Requirement.

With respect to the first criterion, Applicant submits that all three Inventions delineated by the Examiner are directed to a motor vehicle door structure and that all three inventions comprise at least one front door, at least one rear door, and at least one rear door frame. Although the Examiner has made a cursory assertion that the inventions are allegedly distinct because they have acquired a separate status in the art because of their *divergent* subject matter, the Examiner has not stated how the subject matter is divergent or otherwise supported his assertion.

Since the Examiner has indicated that the Inventions are distinct, per MPEP 806.05(j), in order for the Restriction Requirement to be proper, the Examiner must carry the burden to provide an example to support the determination that the inventions are distinct. A mere statement of conclusion is inadequate (MPEP 808.01). Because the Examiner has not provided such example, the Examiner should withdraw the restriction requirement.

With respect to the second criterion, in order to establish reasons for insisting upon restriction, the Examiner must explain why there would be a serious burden on the Examiner if restriction were not required. Although the Examiner has made a cursory assertion that the inventions have a separate status in the art because of their recognized divergent subject matter, the Examiner has neither explained why or how the inventions are divergent nor has cited any patents evidencing such separate status, as required by MPEP 808.02.

Applicant submits that where the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions MPEP 808.02.

In addition, Applicant submits that the search for Inventions A-C would be largely co-extensive because all three inventions have a significant number of limitations in common that would need to be searched for using similar keyword searches. It is important to note that, Invention C consists of only a single claim and therefore a substantial time saving both for the USPTO and for the Applicant would be realized if that invention were examined together with the other inventions.

Accordingly, Applicant respectfully submits that Inventions A-C may be searched and examined together without placing a significant additional burden on the Examiner.

Per MPEP §803, because “the search and examination of all the claims in [this] Application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent and distinct inventions.” Thus, Applicant respectfully traverses the Restriction Requirement, and requests reconsideration, rejoinder of Inventions A-C, and withdrawal of the Restriction Requirement.

Although Applicant believes that restriction is improper, as required by 37 CFR 1.143, Applicant hereby elects with traverse and for examination purposes only Invention A - claims 7-21, and all 6 associated figures (i.e., Fig. 1-6).

The Undersigned states for the record that he has neither spoken by telephone to the Examiner regarding the above restriction requirement, nor has received a call or a voice mail message from the Examiner asking for a call-back to discuss an oral election. For future reference, the Undersigned can be contacted by calling (888) 259-9211 ext 2330, leaving a voice mail message, and requesting call back. Other ways to reach the Undersigned include

regular mail to the address of record, and email to usptoreceipt@gmail.com.

A favorable consideration and early allowance of the claims of this Application are respectfully solicited. Applicant reserves the right to file continuing applications or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicant does not hereby abandon or waive any rights in the non-elected inventions. Applicant reserves the right to petition from the requirement of restriction and to advance other arguments for why the Restriction Requirement is improper. All arguments and statements made herein are for the sole purpose of obviating the requirement for restriction, are not made as to the merits of the invention, and are specifically disclaimed for use by the Office in making any objections or rejections in future office actions directed to the merits.

Customer Number: **33,794**

Respectfully Submitted,
/Matthias Scholl/
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Attorney of Record

Date: August 6, 2007